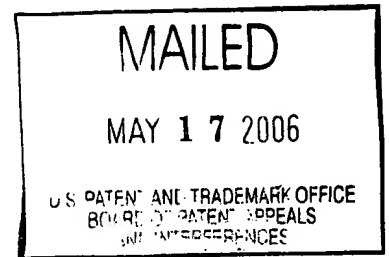UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex <u>parte</u> KAZUE SAKO

_____

Appeal No. 2005-2660
Application No. 09/472,900

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ON BRIEF

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MAILED

MAY 1 7 2006

U S PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HAIRSTON, BLANKENSHIP, and MACDONALD, **Administrative
Patent Judges.**
MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 1-14.

Invention

Appellant's invention relates to a method and system to
provide an electronic tender system, allowing to reduce the
bidding data, and at the same time, to identify the concerned
bidder even when a plurality of bidders have offered the contract
price, and moreover, to keep secret the bidding information of
other bidding prices than that of the successful bidder.
Appellant's specification at page 3, lines 3-9.

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Claim 9 is representative of the claimed invention and is
reproduced as follows:

9.   A method for placing a bid for a contract, comprising:

choosing a bid price to be used in a bid;

obtaining a code parameter associated with the chosen
bid price from a predefined set of code parameters in which
a different code parameter is associated with each of
respective bid prices;

encoding the bid using the code parameter associated
with the chosen bid price in the predefined set; and

transmitting a message including the encoded bid to a
bid receiving system.

References

The reference relied on by the Examiner is as follows:

Franklin et al. (Franklin)   6,055,518   April 25, 2000
                                      (Filed November 12, 1996)

Rejections At Issue

Claim 9 stands rejected under 35 U.S.C. § 102 as being
anticipated by Franklin.

Claims 1-8 and 10-14 stand rejected under 35 U.S.C. § 103 as
being obvious over Franklin.

Throughout our opinion, we make references to the
Appellant's briefs, and to the Examiner's Answer for the
respective details thereof.[1]

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[1] Appellant filed an appeal brief on June 28, 2004. The Examiner
mailed an Examiner's Answer on September 21, 2004. Appellant
filed a reply brief on November 22, 2004.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claim 9 under 35 U.S.C. § 102 and we reverse the Examiner's rejection of claims 1-8 and 10-14 under 35 U.S.C. § 103.

Appellant has indicated that for purposes of this appeal the claims stand or fall together in three groupings. See page 5 of the brief. However, the dispositive argument discussed **infra**, is applicable to all the claims. Therefore, we will consider Appellant's claims as standing or falling together, and we will treat claim 9 as a representative claim of all the claims.

It is our view, after consideration of the record before us, that the disclosure of Franklin does <u>not</u> fully meet the invention as recited in claim 9. Accordingly, we reverse. It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 9, Appellant argues in the Brief and Reply that the Examiner has erred in addressing the "code parameter" limitation of the claim. We agree.

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The Examiner at page 5 of the answer states, "code parameters would inherently be predefined, (such as ASCII or HTML codes)." We see no basis in Appellant's specification or elsewhere for interpreting "code parameters" to be ASCII or HTML codes. To the contrary, Appellant's specification at page 5, lines 11-16, states that the "code parameter" depends on the bidding price and the coding operation is based on the supplied "code parameter." While limitations cannot be imported into the claim from the specification, the terms of the claim must be given their appropriate meaning in light of the specification. In this situation, we find the meaning of "code parameter" is defined by the specification to be something different than ASCII or HTML codes.
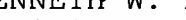
Therefore, we will <u>not</u> sustain the Examiner's rejection under 35 U.S.C. § 102. Similarly, we will <u>not</u> sustain the Examiner's rejections of claims 1-8 and 10-14 under 35 U.S.C. § 103 as they rely on the same interpretation of "code parameters."

Conclusion

In view of the foregoing discussion, we have <u>not</u> sustained the rejection under 35 U.S.C. § 102 of claim 9; and we have <u>not</u> sustained the rejection under 35 U.S.C. § 103 of claims 1-8 and 10-14.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge   )
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)
)
)   BOARD OF PATENT
HOWARD B. BLANKENSHIP   )   APPEALS
Administrative Patent Judge   )   AND
)   INTERFERENCES
)
)
)
ALLEN R. MACDONALD   )
Administrative Patent Judge   )

AM/gw

Appeal No. 2005-2660
Application No. 09/472,900

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